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10/008,282	11/07/2001	Patrick Leempoel	SN - 116	2719

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,282

Applicant(s)

LEEMPOEL ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4, 6 to 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 6 to 9, 15 to 18 is/are rejected.
- 7) ☒ Claim(s) 10 to 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is confusing in that the definition of D first states "the D substituents are independently selected from..." and then states "the remaining D substituents...". It is not clear what is intended by "the remaining D substituents" since it appears that all the D substitutes are fully defined in the first statement. In other words, the phrase "the remaining D substituents" lacks antecedent basis.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in–

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1, 2, 6, 7, 9 and 15 to 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Haas et al.

Haas et al. teaches oil resistant silicones. Particular attention is drawn to Example 1 on column 6. Note that items 1-4, including two surface active fillers and a silanol fluid, are mixed, followed by the addition of an organosilane crosslinking agent 7, and finally the addition of an aminosilane adhesion promoter 8. Since the organosilane and filler are mixed prior to the addition of the adhesion promoter, this meets the claimed process steps, as well as the specific limitations of claims 2, 6, 7, 9, 17 and 18. As can be seen from the teachings on column 5, the cured product of this composition forms a sealant.

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4. Claims 1, 2, 6, 7, 9, 15 to 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Knepper et al.

Knepper et al. teach room temperature vulcanizable silicone compositions. Note for instance Example 1 in which a silanol terminated siloxane is admixed with an organo silane crosslinking agent and untreated silica. Subsequently an aminosilane adhesion promoter is added. Since the organosilane and the silica are added to the composition before the adhesion promoter is added, this meets the claimed process steps. This composition is used to form a sealant.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. or Knepper et al.

The teachings of Haas et al. have been noted supra. With regards to claims 3 and 4, note column 4 of Haas et al. which teaches the addition of an adhesion promoter. This fails to specifically teach the adhesion promoter of claims 3 and 4, but the Examiner takes Official Notice that the adhesion promoters of claims 3 and 4 are very well known and are known to be used in RTV silicone sealant compositions. As such the skilled artisan would have found the addition of this known and commonly used adhesion promoter to the composition of Haas et al. obvious. With regards to claim 8, note the teachings on column 4, lines 10 to 15, which provide motivation for the skilled artisan to use the crosslinking agents claimed.

Similarly, with regards to claims 3 and 4, column 5, lines 21 to 45, of Knepper et al. teaches that the adhesion promoters can be selected from those that are known in the art. Since the adhesion promoters of claims 3 and 4 are both conventionally known and used in the art, the skilled artisan would have found the selection of such to have

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been obvious. With regards to claim 8, note the top of column 4 which teaches the optional inclusion of such crosslinking agents.


7. Claims 10 to 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner cannot find any teaching or suggestion to add the components in the order as claimed. The Examiner notes that each of the working examples cited in the rejections above add the catalyst in the final step and fail to provide any motivation to add the catalyst with the silane and polymer prior to adding the filler.

8. Adachi et al., Dziark et al. and Beljanski et al. are cited as being of general interest. These references teach and/or suggest at least some of the claims, but are not "closer" to the claims than Haas et al. or Knepper et al. No rejection has been made at this time over these reference to avoid redundancy.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
January 2, 2003